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| 10/589,973 | 08/18/2006 | Koichi Hirano | 062853 | 2378 |
| 38834 7590 02/18/2009 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036 | | | | |
| EXAMINER | | | | |
| GUMBS, KEEGAN ROSS | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 4128 | | | | |
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| 02/18/2009 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/589,973

Applicant(s)

HIRANO, KOICHI

Examiner

KEEGAN GUMBS

Art Unit

4128

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 8/18/2006

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a) because they fail to show that the cover member does not approach within the predetermined range (0.2mm) around the writing tip as shown by the dash double-dotted lines, specifically in Figure 4, as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. Claims 1, 2, and 5 are objected to because of the following informalities: the claim status identifier "(Previously Presented)" is incorrect. Appropriate correction is required.

3. The disclosure is objected to because of the following informalities: the description of the significance of the space between the cover member and the tip member, the 0.2mm, is not clearly conveyed. The end of paragraph [0015] recites, "...and a part of the above-mentioned cover member is arranged in dimensions so as not to approach within 0.2 mm of the above-mentioned writing tip when the above-mentioned cover member is fitted along the perimeter surface of the above-mentioned joint member or along the inside of the mounting hole." It is not clear whether the limitation that the cover member is arranged in dimensions so as not to approach within 0.2 mm of the writing tip is only during the process when the cover member is being fitted, or whether that limitation applies after the cover member is fully fitted on the joint member, or during both scenarios. Furthermore, several times the specification recites that "a part" or "the part" of the cover member does not approach within 0.2 mm of the writing tip. It is confusing what "part" of the cover member the applicant is referring to, i.e. the narrower portion, the wider portion, the flanges, etc.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-5 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1 and 2 recite "...said cover member is arranged in dimensions so as not to approach within 0.2 mm of said writing tip when said cover member is fitted..." It is confusing whether the cover member is arranged in dimensions so as not to approach within 0.2 mm of the writing tip only during the process when the cover member is being fitted, or whether that limitation applies after the cover member is fully fitted on the joint member, or during both scenarios.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-5 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1 and 2, the phrase "can" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. Claims 3-5 and 7 depend from claims 1 and 2 and are likewise indefinite.

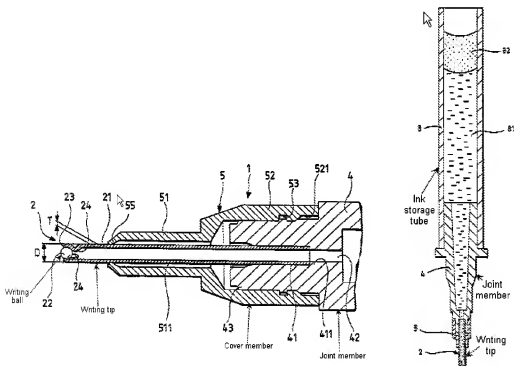
Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

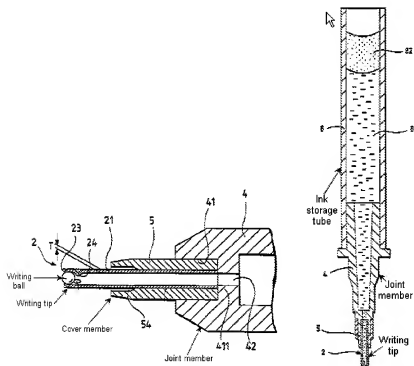
9. Claims 1-5 and 7 (*as presently and best understood*) are rejected under 35

U.S.C. 103(a) as being unpatentable over Sekine et al. (US 6,076,987).



Regarding claim 1, Sekine discloses a ball-point pen having a writing tip which rotatably supports a writing ball, an ink storage tube of which ink is stored, a joint member, and a cover member fitted and mounted along the perimeter surface of the joint member (*see annotated figures above*). Even though Sekine does not specifically disclose that the cover member is arranged in dimensions so as not to approach within 0.2 mm of the writing tip, it, however, would have been obvious to one of ordinary skill in the art at the time the invention was made to use such optimum value since simply

modifying the gap between the cover member and writing tip would involve only routine skill in the art. In other words, the discovering of an optimum distance between the writing tip and cover member is not of innovation but of ordinary skill and common sense. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742, 82 USPQ2d 1385, 1396 (2007).



Regarding claim 2, Sekine discloses a ball-point pen having a writing tip which rotatably supports a writing ball, an ink storage tube of which ink is stored, a joint member, and a cover member fitted and mounted along the inside of a mounting hole formed at the joint member (*see annotated figures above*). Even though Sekine does not specifically disclose that the cover member is arranged in dimensions so as not to approach within 0.2 mm of the writing tip, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use such optimum value since

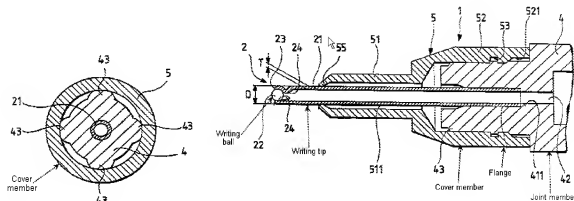
simply modifying the gap between the cover member and writing tip would involve only routine skill in the art. In other words, the discovering of an optimum distance between the writing tip and cover member is not of innovation but of ordinary skill and common sense. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742, 82 USPQ2d 1385, 1396 (2007).

Regarding claim 3, Sekine discloses the cover member is constituted by a metal material (*see col. 5, lines 37-38*).

Regarding claim 3, Sekine discloses the writing tip is formed of a pipe-like tip (*see col. 5, lines 1-4*).

Regarding claim 5, even though Sekine does not specifically disclose that the cover member is arranged in dimensions so as not to approach within 0.2 mm of the writing tip, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use such optimum value since simply modifying the gap between the cover member and writing tip would involve only routine skill in the art. In other words, the discovering of an optimum distance between the writing tip and cover member is not of innovation but of ordinary skill and common sense. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742, 82 USPQ2d 1385, 1396 (2007).

Regarding claim 7, Sekine discloses the cover member is formed into a cylindrical shape and includes a flange formed at one end of the cylindrical portion; the flange coming into contact with an end of the joint member (*see annotated figures below*).



Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Patent Tanka (US 6,602,011 B2), patent Abe et al. (US 6,341,914 B2), patent Hori (US 4,139,313), and patent Liguori (US 4,311,403) describe writing instruments that include a writing tip, writing ball, ink storage tube, joint member, and cover member.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEEGAN GUMBS whose telephone number is (571)270-5608. The examiner can normally be reached on Monday through Friday 7:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Khoa Huynh can be reached on 5712724888. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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